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Application No.: 10/806,070

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TC Art Unit: 3644

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REMARKS

In the most recent Office Action, claims 1-6, 12, 15, 17-19 and 21-41 were examined. Claims 23-26 and 31-41 are withdrawn from consideration. Claims 1-6, 12, 15, 17-19, 21-22 and 27-30 are rejected.

In response, claims 1-5, 15, 17-19, 21-22 and 27-30 are amended. No new matter is added.

Applicant thanks the Examiner for consideration of the invention recited in the present claims of the application, and responds to the comments in the Office Action as follows.

Election/Restrictions

In the most recent Office Action, the Examiner has failed to indicate a disposition with respect to Applicant's request for reconsideration of the election/restriction requirement. Applicant respectfully requests that the restriction requirement be reconsidered and clarification on whether the election is considered to have been made with traverse, as acknowledged in the Office Action dated January 13, 2006. In addition, Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn for all the reasons provided in the response dated April 13, 2006.

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Claim Rejections - 35 U.S.C. § 112

The Office Action states that claims 1-6, 12, 15, 17-19, 21-22 and 27-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action states that the claims include indefinite phrases. Without acceding to the correctness of the rejection, Applicant has amended the claims to improve the clarity of recitation of the invention. Entry is respectfully requested. Applicant also notes that the terms "inner box," "first inner box holder" and "second inner box holder" are uniquely defined in the claims and specification of the present application. The terms are referred to in dependent claims uniformly to maintain appropriate antecedent basis. Accordingly, when the same term is used in different claims with proper antecedent basis, Applicant respectfully submits that there should be no confusion as to identification of the terms based on usage of the same terminology. To the extent that the Examiner believes confusion between identical terms among different claims continues to exist, Applicant respectfully requests clarification as to the source of the confusion.

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With respect to other claim language, such as that indicated in the Office Action with respect to claim 5, Applicant has amended to the claims to clarify the language. Entry is respectfully requested.

In view of the above discussion and amendments to the claims, Applicant respectfully submits that the rejection of claims 1-6, 12, 15, 17-19, 21-22 and 27-30 under 35 U.S.C. § 112, second paragraph, is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. § 102

The Office Action states that claims 1-6, 12, 15, 17-18, 21-22 and 30 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 2002-326630 (JP '630). In particular, the Office Action states that JP '630 teaches each and every element of the rejected claims. Applicant respectfully traverses the rejection.

The Office Action indicates that claim 1 is anticipated by a body 10 disclosed in JP '630. The Office Action states that body 10 comprises an inner box 12 and a first inner box holder 14 and that the inner box 12 and inner box holder 14 are detachably coupled. A review of the disclosure of JP '630 reveals that the

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body 10 is a single contiguous component, formed as a single piece, such that sidewall part 12 and outer frame part 14 are simply parts of the same structure. That is, sidewall part 12 and outer frame part 14 are inseparable as part of body 10. The relationship is clear from the description in JP '630 and the drawing figures, especially Figs. 3 and 5-6. Accordingly, there is no support for the position stated in the Office Action that JP '630 discloses:

the first inner box holder having at least one sidewall and an open lower side and upper side; and

the inner box being detachably coupled with the first inner box holder.

Accordingly, claim 1 recites a number of elements that are not disclosed in JP '630. Because the cited prior art reference of JP '630 does not teach each and every claim element of claim 1, Applicant respectfully submits that the rejection of that claim under 35 U.S.C. § 102(b) is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claims 2-6, 12, 15, 17-18, 21-22 and 30 depend upon and further limit claim 1, and should not be anticipated based on the cited prior art reference of JP '630 for that reason, and also because of the further recitations found in each of the dependent claims. Applicant therefore respectfully submits that the

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rejection of claims 2-6, 12, 15, 17-18, 21-22 and 30 under 35 U.S.C. § 102(b) as anticipated by JP '630 is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action takes the position that recitations found in claims 1-6, 12, 15, 17-19, 21-22 and 27-30 are intended use statements or method limitations that do not patentably distinguish the claimed structure over that of the reference. The position taken in the Office Action is contrary to established case law and without support.

As noted above, claims 1-6, 12, 15, 17-18, 21-22 and 30 include structural limitations that distinguish those claims over the disclosure of JP '630. For example, claim 1 recites:

the first inner box holder having at least one sidewall and an open lower side and upper side,

which neither of sidewall part 12 and outer frame part 14 have in the disclosure of JP '630. In addition, claim 1 recites that the inner box and first inner box holder are detachably coupled. As the Office Action points out, the term "coupled" is sufficient to define a structural limitation as indicated by the cited definition of the term in the American Heritage Dictionary of the English Language, e.g., something that joins or connects; a link.

It is well established that the features of an apparatus may be recited in a claim either structurally or functionally. A

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claim for an apparatus may be distinguished from the prior art in terms of structural limitations. See, e.g., *In re: Schreiber*, 128 F.3d 1473, 1477-78, 44 U.S.P.Q.2d 1429, 1431-32 (Fed. Cir. 1997); MPEP § 2114. A functional limitation does not, in and of itself, render a claim improper. *In re: Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (CCPA 1971); MPEP § 2173.05(g). Accordingly, any functional language that may be recited in the present claims should be acceptable, and the position taken in the Office Action that the functional limitations are statements of intended use or method limitations is inappropriate and without support. Moreover, Applicant submits that claims 1-6, 12, 15, 17-18, 21-22 and 30 recite that structural limitations distinguish the present invention over the disclosure of JP '630.

Claim Rejections - 35 U.S.C. § 103

The Office Action states that claims 19 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '630. In particular, the Office Action states that while JP '630 does not disclose an engaging force greater than a weight of the first inner box holder, the same would have been obvious of one of ordinary skill in the art as a matter of design choice. Applicant respectfully traverses the rejection.

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Claims 19 and 27 recite that the inner box and the first inner box holder can be detachably coupled in a first position and in a second position that is inverted with respect to the first position. The disclosure of JP '630 fails to teach or suggest these limitations. Indeed, as noted above, the sidewall part 12 and outer frame part 14 disclosed in JP '630 are apparently rigidly or permanently fixed to each other as part of the same component, body 10. Accordingly, claims 19 and 27 recite a number of elements that are not taught or suggested in the cited reference of JP '630.

In addition, claims 19 and 27 recite engagement means that detachable couple the inner box and the first inner box holder, which engagement means are also not taught or suggested in the cited prior art reference of JP '630. Furthermore, Applicant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide an engaging force through the engagement means that is greater than a weight of the first inner box holder. By providing such a particular engaging force, the inner box can support the weight of the first inner box holder through the engagement means so that the inner box and first inner box holder are maintained in a particular relationship, such as, for example, the first or second

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position recited in claims 19 and 27. Accordingly, JP '630 does not teach or suggest all the limitations of claims 19 and 27 and one of ordinary skill in the art would not receive any teaching, suggestion or motivation to obtain a detachably coupled inner box and first inner box holder with engagement means that provide a particular engaging force based on the disclosure of JP '630. Thus, the recitation in claims 19 and 27 of the particular engaging force serves to distinguish the present invention over the disclosure of JP '630. Furthermore, claims 19 and 27 ultimately depend upon and further limit claim 1 and should be allowable for the same reasons as claim 1, and also because of the additional limitations recited in each dependent claim.

Applicant therefore respectfully submits that the rejection of claims 19 and 27 under 35 U.S.C. § 103(a) as being unpatentable over JP '630 is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action states that claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '630 in view of JP 2003-170981 (JP '981). In particular, the Office Action states that while JP '630 does not disclose a circumferential projection to engage two boxes together, the same

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is taught by JP '981 in an obvious combination. Applicant respectfully traverses the rejection.

As noted above, claims 28 and 29 include a number of elements not taught or suggested in the disclosure of JP '630 due to their ultimate dependence upon claim 1. As noted above, claim 1 recites a number of elements that are not taught or suggested in the cited prior art reference of JP '630, including a first inner box holder with an open lower side and upper side and the inner box and inner box holder being detachably coupled.

The disclosure of JP '981 does not cure the deficiencies of the disclosure of JP '630, since JP '981 fails to teach or suggest a first inner box holder having an open lower side and upper side, as well as failing to teach or suggest the inner box and first inner box holder being detachably coupled. Accordingly, the cited prior art references of JP '630 and JP '981 fail to teach or suggest a number of limitations recited in claims 28 and 29, either alone or in combination.

Furthermore, claims 28 and 29 call for a circumferential projection that provides an engagement whereby the inner box is detachably coupled with the first inner box holder. The disclosure of JP '981 fails to teach or suggest such a circumferential projection, as it appears that the storing

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containers 2 simply rest inside the packaging container main body 1, without the two being detachably coupled or engaged in any way. That is, the disclosure of JP '981 appears to provide for a number of storing containers 2 situated within a packaging container main body 1, however, the storing containers 2 are not detachably coupled to the packaging container main body 1. Instead, JP '981 appears to require that a storing container 2 be freely disposed in a main body 1 of the container. Accordingly, neither of the cited prior art references teach or suggest all the claim limitations recited in claims 28 and 29, either alone or in combination.

Moreover, Applicant notes that claims 28 and 29 ultimately depend upon and further limit claim 1, and should be allowable for all the reasons claim 1 is allowable. Accordingly, Applicant respectfully requests that the rejection of claims 28 and 29 under 35 U.S.C. §103(a) over JP '981 be reconsidered and withdrawn.

Conclusion

In view of the above amendments and discussion, Applicant respectfully submits that the present application is now in condition for allowance, and earnestly solicits notice to that effect.

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The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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